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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,624	05/11/2001	Roland De La Mettrie	05725.0414-01	5645
22852	7590	01/12/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ELHILO, EISA B	
		ART UNIT	PAPER NUMBER	
		1751		

DATE MAILED: 01/12/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/852,624
Filing Date: May 11, 2001
Appellant(s): METTRIE ET AL.

MAILED
JAN 12 2005
GROUP 1700

Thalia V. Wernement
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 28, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of claimed subject matter (replacing "summary of invention")*

The summary of claimed subject matter contained in the brief is correct.

Further, the examiner reviewed the content of summary of Invention and determined that the items required for summary of claimed subject matter are presented in the brief except that the title should be replace by the new title "Summary of claimed subject matter" according to the new Rules of Practice Before the BPAI (effective September 13, 2004).

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Prior Art of Record

US 6,027,719 *Tomura et al.* **2-2000**

US 6,045,590 *Lim et al.* **4-2000**

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 30-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomura et al. (US 6,027,719) in view of Lim et al. (US 6,045,590). This rejection is set forth in a prior Office Action, mailed on 12/19/2002.

In this rejection the primary reference of Tomura (US, 719) teaches an aqueous hair dyeing composition as claimed in claims 30-35 and 38-42 when the reference teaches a dyeing composition comprises 1.0% of uricase as 2-electron oxidoreductase enzyme, 1.0% of uric acid as a donor, 1.5% of paraphenylenediamine as an oxidation base, 0.12% of meta-phenylenediamine as a coupler, anionic surfactants (see col. 3, lines 41-42) and monoethanolamine (see col. 6, Example 1). Tomura also teaches a process for dyeing hair similar to the claimed process when in the reference's process the dyeing composition as described above is applied to the hair after mixing the dyeing ingredients as claimed in claims 43-45 (see col.6, lines 40-49).

The instant claims differ from the reference by reciting a dyeing composition comprising at least one of the specific anionic surfactants as claimed. Further, the reference fails to teach the claimed addition acid salts as claimed in claims 36-37. Furthermore, the prior art fails to teach a multi-compartment dyeing kit as claimed in claim 46. However, the reference teaches a hair

dyeing composition comprising anionic surfactants (see col. 3, lines 41-42) and inorganic salts such as potassium salt (see col. 6, example I).

Lim (US' 590) in analogous art of hair dyeing composition teaches a composition comprising anionic surfactants such as acylsarcosinates and acylsethionates (see col. 9, lines 41-51) and inorganic or organic acid or acid salts such as sulfuric acid, tartaric acid and citric acid (see col. 10, lines 26-32).

Therefore, in view of teaching of the secondary reference one having ordinary skill in the art would be motivated to modify the primary reference by incorporating the anionic surfactants of acylsarcosinates and acylsethionates and the acid addition salts as taught by Lim to make such a dyeing composition. Such a modification would be obvious because the primary reference suggests the use of anionic surfactants and acid addition salts in the dyeing composition and also the secondary reference clearly, teaches that the a combination of different surfactants can be used in dyeing compositions to impact particular viscosity and foaming properties (see col. 9, lines 49-50) and, thus, a person of the ordinary skill in the art would expect such a dyeing composition to have similar properties to those claimed, absent, unexpected results.

With respect to claim 46, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use such a kits or devices for dyeing hair because the reference teaches that ingredients are mixed for the preparation of such a dyeing composition (see col. 6, lines 41-44), and, thus, a person of ordinary skill in the art would used such a device or kit to separate the dyeing composition.

(10) *Response to Argument*

The examiner has reviewed Appellants arguments and respectfully disagrees with counsel's allegations. Specifically, appellants argue that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. 103 over Tomura et al. in combination with Lim et al., because there is no reasonable expectation of success because Tomura teaches the unpredictability of the dissolution of uric acid, a required Tomura component, and the addition of Lim's ingredients would unpredictably affect uric acid stability.

The examiner position is such that the arguments are not found persuasive because of the following reasons.

In establishing a *prima facie* case of obviousness, three criteria must be met. See *in re Vaeck*, 947 F2d. 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (see MPEP 2143).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case the three criteria have been met, because all references are in the same analogs art in hair dyeing composition.

Tomura et al. (US' 719) teaches a dyeing composition comprising (a) 2-electron oxidoreductase of uricase enzyme, (b) uric acid as a donor for the enzyme and (d) p-phenylenediamine as an oxidation base (see col. 6, Example 1). Tomura et al. also suggests the use of anionic surfactants in the dyeing composition (see col.3, lines 41-42). Lim et al. as a secondary reference clearly teaches that anionic surfactants such as acylsacosinates Acylisethionates and acyltaurines are useful in the hair dyeing composition (see col. 9, lines 39-45). It is further, taught by Lim et al. that a combination of different surfactants can be used to Impart particular viscosity and foaming-properties (see col. 9, lines 48-50), and, thus, there is a sufficient motivation to one having ordinary skill in the art to incorporate the anionic surfactants as taught by Lim et al. in the dyeing composition of Tomura et al. to make such a dyeing composition. Further, there is a reasonable expectation of success for improving the viscosity and foaming properties of the dyeing composition. Therefore, the *prima facie* case of obviousness has been established.

With respect to the appellants' arguments that there is no reasonable expectation of success in combining the teachings of Tomura with Lim, because Tomura uses a hair dye composition that requires stable solubilization of uric acid and wherein some surfactants are not satisfactory in solublizing uric acid whereas Lim does not.

The examiner's position is that one of the objectives of Tomura et al. is to provide a new technique for stably solublizing uric acid in aqueous cosmetic composition that comprises uric acid and a water double polymer (see col. 1, lines 55-59), such a technique is differ from the

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techniques that used in the previous prior art as taught by Tomura et al., and according to the invention of Tomura et al. surfactants such as anionic surfactants can be used in the composition without affecting the stably solubilization of uric acid in aqueous composition based on the new technique provided by Tomura et al.

With respect to the appellants' arguments that Lim recites a list of 23 broad classes of surfactants and two of the instantly claimed anionic surfactants type are included in this list, but the examiner has provided no motivation to pick these two out of Lim's list of 23.

The examiner's position is that Lim et al. teaches three claimed anionic surfactants out of a list of 23 anionic surfactants. Further, it is taught by Lim et al. that a combination of different surfactants can be used (see col. 9, lines 49-50), and, thus, there is a sufficient motivation to one having ordinary skill in the art to select any number or different combinations of surfactants.

Further, a reference that clearly names the claimed species anticipates the claim no matter how many other species are named in the reference (*In re Sivaramakrishnan*, 213 USPQ 441 (CCPA 1982)).

With respect to the appellants' arguments that the examiner fails to address the statement that anionic surfactants can only be added in so far as they do not adversely affect the present invention.

The examiner would like to point out that Tomura et al. teaches a number of ingredients beside the surfactants that can be added in the composition (see col. 3, lines 43-50). Therefore, the reference does not refer specifically to the anionic surfactants that adversely affect the present invention as asserted by the appellants.

With respect to the appellants' arguments that claim 2 of Tomura does not require a surfactant.

The examiner would like to point out that Tomura et al. in claim 2, summarized the part of the disclosure taught in col. 3, lines 41-52, which is the same part that mentioned in the appellants' arguments in the brief on page 12, last paragraph and on page 13, first paragraph, in which the appellants argue that the examiner failed to address the statement at the end of that same paragraph which states that anionic surfactants "can only be added in so far as they do not adversely affected the present invention". Therefore, the examiner believes that there is a contradiction in the appellants' arguments with respect to the presence of anionic surfactants in the dyeing composition of Tomura. However, there is no suggestion in the record that one of ordinary skill would have had any difficulty in understanding or following Tomura's teachings concerning their combination of anionic surfactants and uric acid in an aqueous composition.

Accordingly, the Office maintains that the Examiner has met the burden to establish the prima facie showing of obviousness. Viewed as a whole, the invention as claimed would have been obvious to one of ordinary skill in the art at the time of the invention.

Finally, the Examiner request that this Board when viewing the evidence as a whole, and lacking any secondary indicia of nonobviousness, affirm the decision of the Examiner in whole.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Eisa Elhilo
January 6, 2005

Conferees

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Margaret Einsmann (Primary Examiner 1751)
Mr. Pat Ryan (SPE 1745)

Margaret Einsmann

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